

## **REMARKS**

### **A. Introduction**

Claims 1, 3-5, 7, 8, 10, 11, and 13-15 were pending and under consideration in the application.

In the non-final Office Action of May 6, 2008, claims 1, 3, 5, 8, 10, 11, 14 and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nonaka, U.S. publication no. 2002/0035492 A1 (hereinafter, "*Nonaka*") in view of Akishita, et al., U.S. publication no. 2002/0184259 A1 (hereinafter, "*Akishita*").

Claims 4, 7, and 13 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Nonaka*, in view of *Akishita*, and further in view of Kitaya, U.S. publication no. 2002/015020 A1 (hereinafter, "*Kitaya*").

### **B. Rejections under 35 U.S.C. 103(a)**

1. Claims 1, 3, 5, 8, 10, 11, 14, and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Nonaka* in view of "*Akishita*".

Independent claims, 1, 5, 8, 11, 14, and 15 each recite disabling a process of playing back content of an information storage medium (ISM) when an associated ID of the ISM is identical to a revoked ISM ID listed in a memory of an information processing apparatus. Independent claims, 1, 5, 8, 11, 14 and 15, further recite updating the memory of the apparatus, by replacing a second list of information ISM IDs stored in the memory with a first list stored on the ISM, where the updating is enabled to only operate when the first list is untampered and of a later version than the second list.

*Nonaka* fails to disclose at least the above features of the present invention. *Nonaka*

pertains generally to data distribution techniques wherein data is distributed while suitably clearing rights, controlling copying and distributing profits. *Nonaka*, ¶0002. In accordance with *Nonaka*, a “revocation list” is a list of “unsuitable apparatuses”. *Nonaka*, ¶0138. An unsuitable apparatus is, for example, “one for which some sort of illegitimate action has been performed”. *Nonaka*, ¶0231. *Nonaka* provides for the comparison of a first revocation list stored on a storage medium with a second list stored on an apparatus, and updates the **list stored on the medium** when certain conditions are met. *Nonaka* ¶0228.

The Office Action conceded that *Nonaka* fails to teach updating a revocation list on an apparatus from an information storage medium (ISM). Office Action, ¶9. Moreover, *Nonaka* fails to teach or suggest updating the memory of the apparatus, by replacing the list of ISM IDs stored in the memory with a list stored on the ISM, where the updating is enabled to only operate when the first list is untampered and of a later version than the second list.

If anything, *Nonaka teaches away* from the present invention because *Nonaka* discloses updating a list of revoked **apparatus IDs stored on a medium** with a list stored on an apparatus. *Nonaka* ¶0228.

The Office Action asserted that *Akishita* discloses updating a revocation list on an apparatus from an external source, such as a portable storage medium. Office Action, ¶10, citing *Akishita*, paragraphs 0023, 0030, 0031, 0043, 0566-0575. This assertion is not supported by the actual text of the reference. *Akishita* only describes updating a revocation list on a device whereby a communication unit 201 (described at paragraph 0181 and illustrated in fig. 2) is operable to transmit and receive data over an external communications medium or network such as the Internet. A control unit receives an “updating revocation list” from the communication unit (paragraph 0569) and, under certain conditions, replaces a revocation list with the “updating revocation list”. As illustrated in fig. 2 and described at paragraph 0181, the “updating revocation list” may only be obtained by communication unit 201 from the external communications medium or network with which it is operable. *Akishita*, at most, describes how

a revocation list on a device communicatively coupled to a network, might be updated with an updating revocation list received from the network.

Thus, the disclosure of *Akishita* also fails to teach or suggest updating a revocation list on an apparatus from an information storage medium (ISM) by replacing the list of ISM IDs stored in a memory of the apparatus with a list stored on the ISM, where the updating is enabled to only operate when the first list is untampered and of a later version than the second list. Because this feature is not taught or suggested by the cited prior art, the Office Action failed to establish that the invention as a whole is obvious in light thereof. See MPEP 2143.03. "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F. 2d 1382, 1385. (CCPA 1970).

2. Claims 4, 7, and 13 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Nonaka*, in view of *Akishita*, and further in view of *Kitaya*".

The Office Action cited *Kitaya* for teaching that an enabling key block is encryption key information that can be decrypted based on a device node key provided in the form of a hierarchical key-distribution tree structure to an information processing apparatus that is a device using the information storage medium. Whether or not this is true, *Kitaya* fails to cure the deficiencies noted above.

Accordingly, claims, 4, 7 and 13 are patentable over the combination of *Nonaka* and *Kitaya*.

### **C. Conclusion**

In view of the foregoing, it is submitted that claims 1, 3-5, 7, 8, 10, 11, and 13-15 are allowable and that the application is in condition for allowance. Early notice to that effect is respectfully requested.

Serial No.: 10/550,001  
Docket No.: 09792909-6374  
Response to Office Action dated September 3, 2008  
Reply to the non-final Office Action mailed May 6, 2008

If any further fees are required in connection with the filing of this amendment, please charge the same to our Deposit Account No. 19-3140.

Respectfully submitted,

SONNENSCHN NATH & ROSENTHAL LLP

By / Michael L. Day /

Michael L. Day, Reg. No. 55,101  
P.O. Box 061080  
Wacker Drive Station, Sears Tower  
Chicago, IL 60606-1080  
415-882-5064 (telephone)  
415-882-0300 (facsimile)  
ATTORNEYS FOR APPLICANTS